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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,726	12/05/2003	Thomas C. Burke	NEX-101-US	1726
24390	7590	01/24/2006		
LUCASH, GESMER & UPDEGROVE, LLP 40 BROAD ST SUITE 300 BOSTON, MA 02109			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/728,726	<b>Applicant(s)</b> BURKE ET AL.	
	<b>Examiner</b> Lawrence D. Ferguson	<b>Art Unit</b> 1774	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***DETAILED ACTION***

***Claim Rejections – 35 USC 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 lacks antecedent basis for the phrase, "the migratory additive." Claim 1, which claim 5 depends from does not disclose a migratory additive.

***Claim Objection***

3. Claims 10-11 are objected to because of the following informalities: Claim 11 appears to be included within the context of claim 10. Claim 11 needs to be in a space that is separate from the disclosure of claim 10. Appropriate correction is required.

***Claim Rejections – 35 USC § 102(b)***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Stolk (U.S. 6,063,445).

Stolk discloses a thin polymer film having a thickness of less than 1 mil comprising polyester terephthalate material (column 3, lines 52-55; column 5, lines 9-11, 41-42 and column 6, lines 4-5, 29-30).

***Claim Rejections – 35 USC § 102(b)***

6. Claims 1, 3, 5, 7-8, 10 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al (U.S. 6,503,611).

Chang discloses a polymer film comprising polymer resin and a printed surface (column 2, lines 40-49) comprising at least two layers, having a first polyolefin-based resin layer and a second polyolefin mixed resin layer having a first and second additive material and stable slip and coefficient of friction (COF) properties (column 2, lines 15-35). Chang further teaches the film comprises polypropylene and fatty amides such as erucamide and stearamide (column 1, lines 10-15, 28-35; column 3, lines 7-10 and column 4, lines 31-40). The film has a thickness of 12 $\mu$ m (.472mils) (column 3, lines 40-50).

***Claim Rejections – 35 USC § 102(b)***

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7. Claims 1-3, 5, 7-8, 10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al (U.S. 6,902,822).

Chang discloses a polymeric film comprising polypropylene and has a stable coefficient of friction (COF) (column 1, lines 11-17, 63-67 and column 2, lines 48-64) along with a polyolefin film comprising at least two layers, where the first layer comprises a first additive material containing up to 800ppm of fatty amides including stearamide or erucamide and the second additive material in the amount of less than 1000ppm (column 2, lines 1-33). The film has a thickness of 0.7 mils (column 3, lines 30-35 and column 4, lines 25-30, 43-45). It is inherent for the film of Chang to have the structures as in claims 4 and 9 since the primary amide is erucamide and the secondary amide is stearamide. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

***Claim Rejections – 35 USC § 103(a)***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al (U.S. 6,902,822).

Chang is relied on for claims 1 and 7. Chang does not explicitly disclose the ratio of the primary amide and secondary amide. The ratio of the primary and secondary amides are an optimizable feature. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering the optimum or workable range involves only routine skill in the art. The ratio of the primary and secondary amides directly affect the surface smoothness of the polymeric film. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215.

***Claim Rejections – 35 USC § 103(a)***

10. Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al (U.S. 6,902,822) in view of Creekmore et al (U.S. 4,112,158).

Chang is relied on for claims 1 and 7. Chang does not explicitly disclose a secondary amide such as oleic palmitamide. Creekmore teaches a film comprising stearyl erucamide and oleic palmitamide (abstract, column 2, lines 1-15 and column 5,

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lines 18-20) where the polymeric film has a thickness of 0.5-20mil (column 1, lines 7-8 and lines 40-42). The film of Creekmore comprises polyethylene (column 3, lines 47-48). Chang and Creekmore are both related to thin polymeric films. Therefore, it would have been obvious to one of ordinary skill in the art to have employed the stearyl erucamide and oleic palmitamide, as taught in Creekmore, in the polymeric film of Chang because the stearyl erucamide and oleic palmitamide material provides improved surface smoothness of the polymeric film.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson  
Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER

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